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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of : Maa, Shalong / *Ex parte*

Appeal No. : 2001-0908

Application No. : 08/833,342

Filing Date : April 04, 1997

For : "Computer-Controlled Talking Toy Figure with Animated Features"

Art Unit / Examiner : 3721 (3713) / Paradiso, J

**Chief Administrative Patent Judge
Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
Washington, D.C. 20231**

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U.S. PATENT AND TRADEMARK OFFICE

Dear Sir:

PETITION TO THE CHIEF ADMINISTRATIVE PATENT JUDGE OF THE BOARD OF
PATENT APPEALS AND INTERFERENCES UNDER 37 C.F.R. §1.182

1. With respect to the above-identified patent application and appeal, the undersigned Petitioner / Appellant respectfully petitions the Board of Patent Appeals and Interferences (the "Board"), under 37 C.F.R. § 1.182, to (i) make the application special so as to expedite the appeal proceeding, and (ii) release the application file for copying and verify the genuineness of the "Examiner's Answer" (Paper No. 34, EXHIBIT A), filed 12/28/2000 and received by Appellant / Petitioner in answer to Appellant's "Appeal Brief".

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I. PETITION TO MAKE THE APPLICATION SPECIAL

2. Petitioner has previously filed a petition to make the application special under 37 C.F.R. § 1.102 on 04/30/2001 (Paper No. 40), based on the requirement set forth in the "Manual of Patent Examining Procedure" (M.P.E.P.) §708.02-I and on Appellant's statements therein with respect to prospective manufacture of the products and services described in the above-identified patent application, with a copy of a fund-raising Business Plan attached thereto. The petition was dismissed

by the Program and Resource Administrator, Mr. Craig R. Feinberg, of the Board on the ground that said Appellant's statements therein do not precisely comply with the requirements set forth in M.P.E.P. §708.02, as so stated in the "Decision on Petition to Make Special" dated 05/07/2001 (Paper No. 41)

3. Petitioner hereby, again, respectfully petitions the Board to make the application special, so as to expedite the appeal proceeding, on the grounds that, (i) there has been substantial delay in the examination proceeding caused, in part, by the Examiners not following the procedures set forth in M.P.E.P., which has resulted in the right of Petitioner being unduly prejudiced, (ii) Petitioner's exercise of due care and diligence in prosecution and advancing the application / appeal proceedings has been shown throughout the application / appeal proceedings, and (iii) the present application has been pending more than five years, as depicted in detailed in the ensuing Paragraphs 4-9.

4. Petitioner respectfully submits that there has been substantial undue delay in the examination proceeding by the Examiners assigned to the present application. For examples, (i) Petitioner' / Applicant's "Request for Reconsideration" (Paper No. 15) in response to the First Office was filed on 10/27/1999; The ensuing second and final "Office Action", dated 05/15/2000 (Paper No. 22), was sent to the undersigned Petitioner / Applicant more six and half (6.5) months thereafter; (ii) The "Examiner's Answer" (Paper No. 34, EXHIBIT A) dated 12/28/2000 in answer to Petitioner' / Applicant's "Appeal Brief" was sent to Petitioner / Applicant more than six and half (6.5) months after the filing of the original and complete Appeal Brief on 06/06/2000 (Paper No. 25)(see EXHIBIT C[†]); and (iii) the application file was transferred to the Board from the examination group more than sixteen (16) months after Petitioner' / Applicant's 10/27/1999 "Request for Reconsideration" (Paper No. 15), although Petitioner / Applicant was anxiously looking forward to advancing the application proceedings and having the jurisdiction thereover passed to the Board.

5. Petitioner respectfully submits that the Examiners' refusal of following the examining procedures set forth in M.P.E.P. has resulted, in part, in the foregoing delays and in Petitioner's right being unduly prejudiced. For examples:

- (i) According to M.P.E.P. § 1208, "The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the Brief by the examiner";

However, as described above, the "Examiner's Answer" (Paper No. 34) dated 12/28/2000 was sent to the Petitioner / Appellant more than six and half (6.5) months after the filing of the original complete "Appeal Brief" on 06/06/2000 (Paper No. 25);

(ii) According to M.P.E.P. § 1206, "The brief of a *pro se* appellant which does not contain all of the items, (1) to (9), specified in 37 C.F.R. § 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8)"; Thus, the Examiners' "Notification of Non-compliance with 37 C.F.R. § 1.192(c)" (EXHIBIT B, Paper No. 28), dated 07/26/2000 and reciting 37 C.F.R. § 1.192(c)(9) with respect to appending correct copy of amended Claims in the Appeal Brief filed 06/06/2000 (Paper No. 25) as cause thereof, does not comply with such procedure set forth in M.P.E.P. § 1206, which has resulted, in part, in the foregoing delay; Furthermore, Petitioner' / Appellant's original Appeal Brief filed 06/06/2000 (Paper No. 25) does comply with the requirements of 37 C.F.R. § 1.192(c)(9), since it does include an appendix containing a copy of the Claims involved in the appeal, with a copy of the amendment thereof attached thereto (EXHIBIT C[†]).

(iii) Chapters 2100 and 700 of M.P.E.P. provide extensive coverage of the procedures and requirements for Examiner to apply authorities, such as binding legal precedent established by prior case law, in allowing and rejecting claims. Petitioner / Applicant has made repeated requests that the Examiners follow such legal authorities in rejecting claims and in response to Petitioner' / Applicant's such citation of legal precedent / authorities, as so stated in the "Appeal Brief" filed 06/06/2000 and 08/29/2000 (Paper No. 25, Pages 4-5, Section VIII.1), in the "Response to Office Action" filed 10/27/1999 (Paper No. 15, Page 9, Paragraphs 14.1-14.2), and in the "Petition to Invoke Supervisory Authority of the Commissioner" filed 06/16/2000 (EXHIBIT D[†], Pages 6-7, Section 9). In response thereto, the Examiners states in the "Examiner's Answer" (Paper No. 34), filed 12/28/2000 in answer to Petitioner' / Appellant's "Appeal Brief", that "Appellant is apparently requesting a discussion of the legal precedents regarding the case. However, the Examiner has made the rejections based on the claims and the prior art [(note) *i.e. the Examiner's understanding thereof*],, not on legal arguments, ..." (see page 8 of "EXHIBIT A").

(iv) The "Office Action" filed 05/15/2000 (Paper No. 22, Page 16) refers to "*In re Fine*, 837 F.2d 1071, 5 USPQ2d 15 (Fed. Cir. 1988)" and "*In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) in supporting the Examiner's obviousness rejections therein. Petitioner acknowledges that discussions of the court decisions in "*In re Fine*" and "*In re Jones*" are provided in M.P.E.P. § 2143.01, which apparently states that the court decisions in both two cases reversed the obviousness rejections. (see Page 5 of the "Appeal Brief" filed 06/06/2000, Paper No. 25)

6. The petitioner respectfully requests that the Administrative Patent Judge consider the prejudice to the undersigned Petitioner as a result of the foregoing Examiner's refusal of following the procedures set forth in M.P.E.P. Petitioner attached a "Business Plan" to the previous "Petition to make the Application Special under 37 C.F.R. § 1.102" filed 04/30/2001 (Paper No. 40). As shown therein, if a patent is granted on the Application, it will serve as the intellectual foundation for the company's entire business operation and for obtaining equity capital investment. The technology disclosed in the Application pertains to new interactive digital media and computer network. Thus, a granted patent is essential for the company to obtain start-up financing, and the timing thereof is crucial to the competitive advantage of the business.

7. In accordance with M.P.E.P. § 1204, an applicant's diligent prosecution is essential to a favorable decision on a petition to make special. Petitioner respectfully represents that Petitioner has been exercising due care and diligence in prosecution and advancing the application / appeal proceedings, as evidenced by, (1) Petitioner's present and previous (filed 04/30/2001 as Paper No. 40) petitions to make the application special, (2) Petitioner's repeated written and telephone inquiries (EXHIBITS E[†]1-2 and E3-4) about the status of the application and examination proceedings and Petitioner's concern for the delay thereof, and (3) Petitioner's previous two petitions, filed 02/05/2001 and 02/15/2001 respectively (Paper Nos. 35 and 36) for requesting advancement of the application and appeal proceedings.

8. The present application has been pending five (5) years (the filing date is 04/04/1997). According to M.P.E.P. § 707.02, , "an application that has been pending five years should be carefully studied ... and every effort made to terminate its prosecution".

9. Conclusion

For the foregoing reasons, and pursuant to 37 C.F.R. §1.182, it is respectfully requested that "special" status be accorded to the present application / appeal, and that the present appeal proceeding be advanced according to, (i) the filing date of Petitioner's "Request for Reconsideration" (10/27/1999)(Paper No. 15) in response to the First Office, (ii) the filing date of the original "Appeal Brief" (06/06/2000)(Paper No. 25), (iii) Petitioner's exercise of due care and diligence in prosecution and in advancing the application / appeal proceedings, and (iv) the fact that the present application has been pending five (5) years, and taking into account that Petitioner has been unduly prejudiced as a result of Examiner's refusal of following the procedures set forth in M.P.E.P., as described in details herein above.

II. PETITION TO RELEASE THE APPLICATION FILE FOR COPYING /INSPECTION AND TO VERIFY THE GENUINENESS OF THE "EXAMINER'S ANSWER"

10. The undersigned petitioner has been having difficulties in obtaining certified copies of certain papers, including the "Examiner's Answer" filed 12/28/2000 (EXHIBIT A, Paper No. 34), in the file wrapper of the above-identified application from the Office of Public Record (OPR). The following is a summary of the communications between Petitioner and the OPR in attempting to obtain said certified copies:

- (a) On 12/17/2000, Petitioner submitted a "Request for Certified Copies of File Wrapper and All Contents", including a payment of document supply fee therefore for \$150. (EXHIBIT F1[†]);
- (b) On 01/09/2001, Petitioner submitted another "Request for Certified Copies of File Wrapper and All Contents", including the document supply fee therefore for \$150. (EXHIBIT F2)
- (c) On 01/19/2001, Petitioner's original 01/09/2000 submissions (see subsection (b) above), including the envelop, the fee, and the statement of Request, were returned to Petitioner (EXHIBIT F2) by the OPR, together with a notice (EXHIBIT F2), requesting Petitioner to furnish the Office with \$75 to complete the processing of Petitioner's order, and showing that the total amount to process the order is \$225.

- (d) On 02/09/2001, Petitioner submitted a credit card payment of \$75 (EXHIBIT F4[†]) in response to the aforementioned notice from the OPR (subsection (c) above).
- (e) On 02/16/2001, Petitioner was informed by Ms. Brown of the OPR that Petitioner's 12/17/2000 submissions were deemed missing (thus, more fee were due for processing Petitioner's order of certified copies) (see "Telephone Interview Summary", EXHIBIT F3[†]), even though Petitioner did receive the returned postcard receipt from the Office (EXHIBIT F1[†]), showing that the Office has received Petitioner's 12/17/2000 submissions.
- (f) Thereafter (subsection (e) above), Petitioner authorized the OPR to charge his credit card account for \$225 for the order, pursuant to 37 C.F.R. §1.19(b)(2). The payment was accepted by the Office (EXHIBIT F7).
- (g) On 02/19/2001, Petitioner submitted a notice (EXHIBIT F5[†]), via both facsimile and first class postal mail, to Mr. B. Fenwick, supervisor of the OPR, for expressing Petitioner's concern for the aforementioned paper missing (see subsection (e) above).
- (h) Thereafter (subsection (g) above), Petitioner made several attempts to contact Mr. Fenwick by phone, including three voice messages, and has not received any response therefrom.
- (i) On 03/26/2001, Petitioner filed a "Petitioner to the Deputy Commissioner" (EXHIBIT F6), for requesting the Deputy Commissioner to review certain irregularities in the present application proceeding, including Petitioner not being able to obtain certified copies of papers in the application file (Note that, (1). Petitioner was informed that the "Office of Petitions" does not have jurisdiction over matters concerning the OPR; and (2). Petitioner did not know whether the application file was transferred to the Board)
- (j) Thereafter (subsection (i) above), Petitioner was finally informed by the OPR that more fees were due in connection with Petitioner's order of certified copies, since the file wrapper consists of more than 400 pages (37 C.F.R. §1.19(b)(2)).
- (k) On 04/26/2001, Petitioner submitted, via facsimile to Ms. Gloria Murray of the OPR, an amended request, i.e., "Request for Certified Copies of Selected Papers in the Application

File" (EXHIBIT F8), for requesting certified copies of eight documents in the application file, such that the document supply fee submitted to the Office (subsection (f) above) are sufficient therefore.

- (l) Thereafter, Petitioner did receive two of the eight requested items (EXHIBIT F8), including certified copies of (i) the Non-Provisional Patent Application filed 04/04/1997 and (ii) the Provisional Patent Application filed 04/05/1996. Petitioner was informed by the Program and Resource Administrator, Mr. Craig R. Feinberg, of the Board that the Judge of the Board had decided to withhold the application file, and thus, other items requested were not available to the OPR for copying.

11. The foregoing is a showing that Petitioner has made diligent effort for attempting to obtain said certified copies (EXHIBIT F8). Since the application file is now in the custody of and is withheld by (subparagraph 10(l) above) the Board, the present petition respectfully requests, pursuant to 37 C.F.R. § 1.182, that the Board release the application file to the OPR for copying so as to complete the processing of Petitioner's request for certified copies (see EXHIBIT F8).

12. As described in Section I above, examiner's refusal of following the procedures set forth in M.P.E.P. and certain statement in the "Examiner's Answer" dated 12/28/2000 (Paper No. 34) took Petitioner by surprise. Therefore, Petitioner believes that it is reasonable and necessary for requesting verification of the genuineness of the "Examiner's Answer" dated 12/28/2000 (Paper No. 34), and respectfully requests the Board to provide such verification according to the record in the application file, which is now in the custody of the Board. A copy of the "Examiner's Answer" (Paper No. 34) received by Petitioner is attached hereto as "EXHIBIT A".

III. CONCLUSION


13. For the foregoing reasons, the undersigned Petitioner respectfully petitions the Board, under 37 C.F.R. § 1.182, to (i) make the application special so as to expedite the appeal proceeding, and (ii) release the application file for copying by the OPR and verify the genuineness of the "Examiner's Answer" (Paper No. 34) attached hereto.

14. The required petition fee (37 C.F.R. § 1.17(h) and 1.182) is enclosed in this communication. Should more fees be due in connection with this paper, please contact the undersigned Petitioner at (972) 618-7875.

Respectfully submitted,

SIGNED on April 13, 2002

By:


Shalong Maa, Ph.D.,
pro se Applicant / Petitioner
P. O. Box 261458
Plano, TX 75026
(972) 618-7875

[†] copy of the returned postcard receipt is included.